



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

2

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/627,519

07/25/2003

Bernhard Keppler

8182-25US (PA32424US)

2897

570

7590

08/17/2006

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

SHIAO, REI TSANG

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/627,519	Applicant(s) KEPPLER, BERNHARD	
	Examiner Robert Shiao	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 37 is/are rejected.
- 7) ☒ Claim(s) 33-36,38 and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application claims benefit of the foreign application:
GERMANY 101 03 565.9 with a filing date 01/26/2001.
2. Amendment of claims 33-35, cancellation of claims 1-21 and 40-41, and a filed declaration under 37 C.F.R. 1.132 in the amendment filed on June 05, 2006, is acknowledged. Claims 33-39 are pending in the application.

Responses to Amendment/Arguments

3. The rejection of claims 33-37 under 35 U.S.C. 112, second paragraph, has been overcome in the amendment filed on June 05, 2006.
4. Applicant's arguments regarding the rejection of claim 37 under 35 U.S.C. 112, first paragraph, filed on June 05, 2006, have been fully considered but they are not persuasive. The rejection of claim 37 under 35 U.S.C. 112, first paragraph, i.e., the enablement of all "inhibiting tumor activity", is maintained. However, applicant's filed declaration dated June 05, 2006, has disclosed that a number of cancer cells have been inhibited by the instant compositions in terms of IC_{50} (μM), see Table 2 on the page 10. Incorporation of the named cancer (i.e., epidermoid, prostate, colon, lung, or renal cell carcinoma, and melanoma) into claim 37 would obviate the rejection.
5. Applicant's arguments regarding the rejection of claims 33-37 under 35 U.S.C. 102(b) filed on June 05, 2006, have been fully considered and they are persuasive. The instant compositions are distinct from Keller et al., the rejection of claims 33-37 under 35 U.S.C. 102 (b) has been withdrawn.

Art Unit: 1626

6. Applicant's arguments regarding the rejection of claims 33-39 under 35 U.S.C. 103(a) or under the obviousness-type double patenting filed on June 05, 2006, have been fully considered and they are persuasive. The instant compositions are distinct from Keller et al., the rejection of claims 33-39 under 35 U.S.C.103 (a) or under the obviousness-type double patenting has been withdrawn.

Claim Objections

7. Claims 33-39 are objected to as containing non-elected subject matter, i.e., the variable B or B' of heterocycle of formula (I), (II) or (III) only represents imidazol, pyrazole, triazol or indazol thereof. It is suggested that applicants amend the claims to the scope of the elected subject matter as defined in the scope of the previous Office action, see paragraph 4 of the Office action dated 01/05/2006.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1626

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1626

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER

for *Kamal Saeed*
Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626

R3-

Robert Shiao, Ph.D.
Patent Examiner
Art Unit 1626

August 11, 2006